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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,432	03/01/2004	Rick James Morse	D0932-00431	9791
8933	7590	03/22/2007		
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			EXAMINER KENNY, DANIEL J	
			ART UNIT	PAPER NUMBER
			3635	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/790,432

Applicant(s)

MORSE, RICK JAMES

Examiner

Dan Kenny

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-13 and 15-22 is/are rejected.
- 7) ☐ Claim(s) 8, 9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II, claims 1-14 in the reply filed on 1/5/2007 is acknowledged. However, in view of the amendment, the restriction is hereby withdrawn.

Information Disclosure Statement

The information contained in the information disclosure statement (IDS) submitted on 3/1/2004 was considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "horizontal member". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Paradisi et al. (4,054,012).

Paradisi discloses a folded metal (col. 2, line 35) starter strip (14) comprising:

a fastener flange (18);

a siding support element (ss) connected to the flange, wherein the support element has a front face (f);

a spacer element (sp, see darkened portion shown at annotated Fig. 3 directly below) connected to the siding support element, wherein the spacer includes an angle component (a) wherein the front face and the angle component are inclined at an equal angle away from vertical; and

a flashing element (38, 40) connected to the spacer element, wherein the flashing element includes a horizontal (38) member wherein an end extends beyond the plane of fastening flange and an end terminates at a point even with the plane of the fastening flange, and a vertical (40) member.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Paradisi et al.

Paradisi et al. discloses all the claimed elements as described above, including:

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the spacer element including a spacing component (spc) connected to the siding support element;

an angle component (a) connected to the spacing component, and;

a bottom component (b) connected to the angle component.

Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Paradisi et al.

Paradisi discloses a folded metal (col. 2, line 35) starter strip (14) comprising:

a fastener flange (18);

a siding support element (ssup, see annotated Fig. 3 below) connected to the flange, wherein the support element further includes a first (fh) and second (sh) horizontal member which are substantially perpendicular to the fastener flange;

a spacer element (spa) connected to the siding support element; and

a flashing element (20) connected to the spacer element.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamlyn (5,916,095).

Tamlyn discloses a (note: The product by process limitation, extruded, does not structurally define over the reference as applied to the claims because the reference article is made of plastic) plastic (col. 4, line 12) starter strip (20) comprising:

a fastener flange (28);

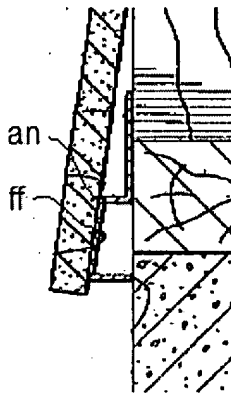
a siding support element (32) connected (connected via 30) to the flange,

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wherein the support element has a front face (ff);

a spacer element (30) connected to the siding support element, wherein the spacer includes an angle component (an) wherein the front face and the angle component are inclined at an equal 3° angle ($\tan^{-1} \frac{1}{2} \approx 3^\circ$, col. 4, lines 39-45) away from vertical; and

a flashing element (34) connected to the spacer element.



Annotated Fig. 1 (U.S. Pat. 5,916,095)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamlyn in view of Weber (3,173,229).

Tamlyn discloses a building system comprising a starter strip as described above, including a fiber cement siding panel (col. 5 line 33).

Tamlyn does not expressly disclose a foundation, a sill plate installed on and substantially even with the foundation, wall studs attached to and substantially even with the sill plate, a sheathing attached to an outside surface of the wall studs and sill plate and having a bottom edge which terminates at the bottom edge of the sill plate, and the siding panel wherein a bottom edge of the panel abuts a bottom component of the spacer element; wherein a horizontal member of the flashing element is flush against the bottom edge of the sheathing and terminates at a top edge of the foundation.

Weber discloses a building system comprising a starter strip (c'), a foundation (11), a sill plate (10) installed on and substantially even with the foundation, wall studs (12) attached to and substantially even with the sill plate, a sheathing (solid body portion, 20', is considered to be sheathing as broadly stated) attached to an outside surface of the wall studs and sill plate and having a bottom edge which terminates at the bottom edge of the sill plate, and the siding panel wherein a bottom edge of the panel abuts a bottom component of a spacer element (23); wherein a horizontal member (22)

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is flush against the bottom edge of the sheathing and terminates at a top edge of the foundation.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to include the bottom component as taught by Weber in the structure of Tamlyn to support the siding, and to include the horizontal member flush against the bottom edge of the sheathing and terminating at a top edge of the foundation to prevent water from contacting the sheathing and plate.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamlyn in view of Weber and in further view of O'Neal (5,575,127).

Tamlyn in view of Weber discloses a building system comprising a starter strip as described in the above rejection of claims 15-17. Tamlyn in view of Weber does not expressly disclose a building system wherein an outside surface of the sheathing is flush with an outside surface of the foundation.

However, it is well known in the art to provide a starter strip horizontal member to protect the sheathing in a construction wherein the sheathing is flush with the foundation. Reference O'Neal teaching a starter strip horizontal member (42) to protect the sheathing in a construction wherein the sheathing (6) is flush with the foundation. Therefore, it would have been obvious and well within the level of one skilled in the art at the time the present invention was made to modify the system of Tamlyn in view of Weber using a horizontal member to protect the sheathing in a construction wherein the sheathing is flush with the foundation as taught by O'Neal.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamlyn in view of Weber. Claims 20-22 are an obvious method of using the building system of Tamlyn modified by Weber, the method further including the step of fastening the starter strip (col. 4, line 66).

Allowable Subject Matter

Claims 8, 9, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kenny whose telephone number is (571) 272-9951. The examiner can normally be reached on Monday thru Friday, 9 am to 5 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

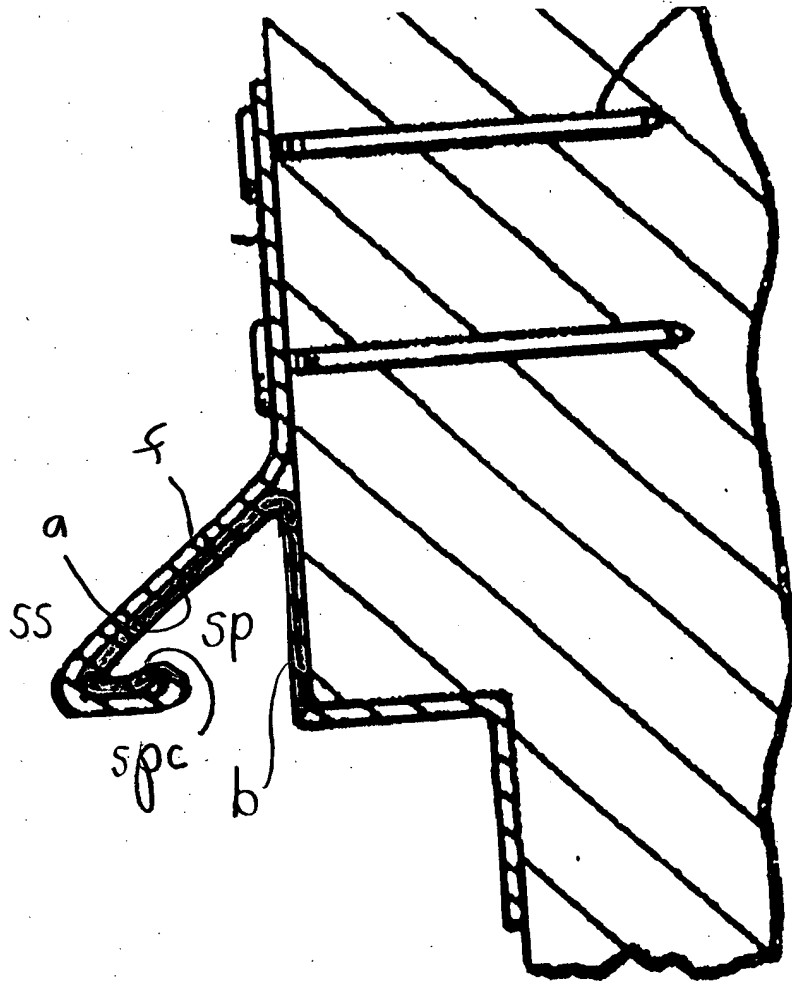
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

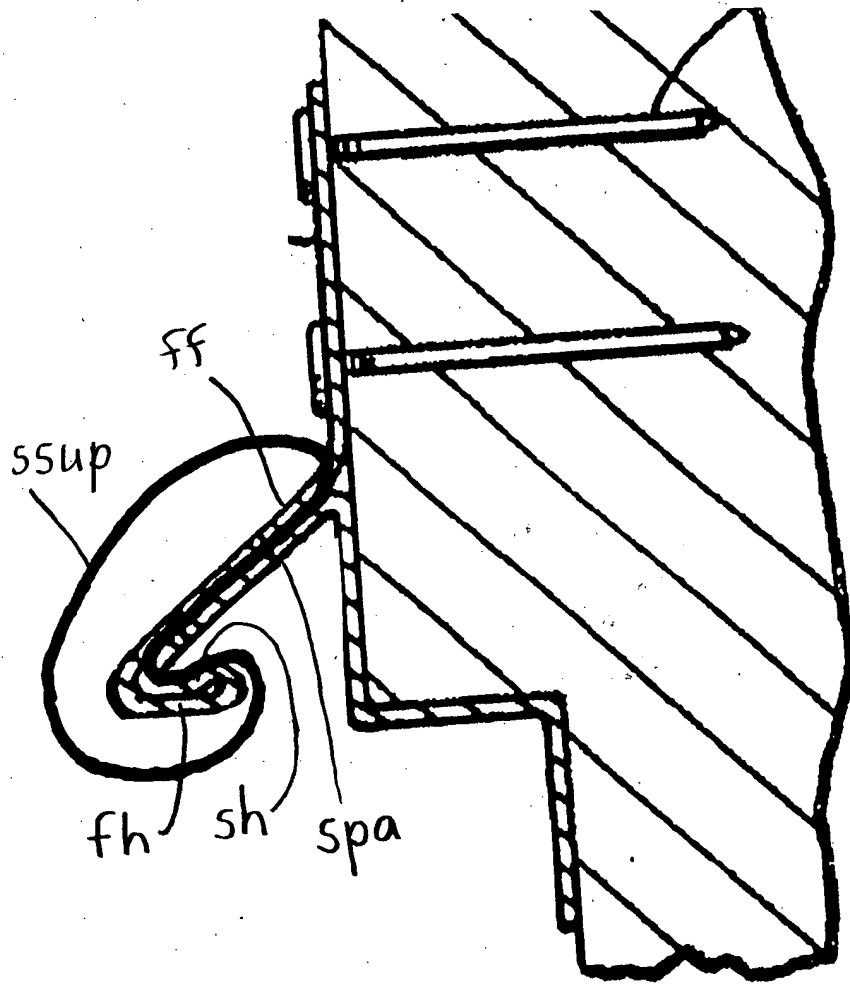
DK *DSK.*

3/16/2007


JEANETTE E. CHAPMAN
PRIMARY EXAMINER
GROUP 3400-3635



Annotated Fig. 3 (U.S. Pat. 4,034,012)



Annotated Fig. 3 (U.S. Pat. 4,054,012)